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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,803	06/12/2000	HERVE CROZIER	365-444P	3623
2292	7590	08/19/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			LEE, RIP A	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			1713	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/530,803	CROZIER, HERVE	
	<b>Examiner</b> Rip A. Lee	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 29 June 2005.

2a)  This action is FINAL.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-5 and 7-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5 and 7-15 is/are rejected.

7)  Claim(s) 2-5, 7-9 and 12-14 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## DETAILED ACTION

This office action follows a request for continued examination (RCE) under 37 § C.F.R. 1.114, filed on June 29, 2005. Applicants have amended claims 1 and 10. Claims 1-5 and 7-15 remain for prosecution.

### *Claim Objections*

1. Claims 2-5, 7-9, and 12-14 are objected to because of the following informalities: Claims need to be amended so that they are drawn to a molded article as per claim 1. Appropriate corrections are required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10, 11, and 15 provide for the use of a modified catalyst (step (b)), but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10, 11, and 15 are also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,551,501 to Shiga *et al.* alone, or in view of U.S. Patent No. 4,670,491 to Stretanski *et al.* and/or U.S. Patent No. 4,192,794 to Wang *et al.* for the same reasons set forth in previous office actions.

Shiga *et al.* discloses a molded article made from a polymer composition comprising a blend of crystalline polypropylene and 0.05-10,000 ppm by weight of a vinyl cycloalkane (claim 1). Treatment of a Ti/Et<sub>3</sub>Al catalyst with vinyl cyclohexane for 15 minutes results in the formation of poly(vinyl cyclohexane) containing the active catalyst. In a subsequent step, propylene is polymerized in the presence of the catalyst modified with a polymer containing vinyl units, prepared previously (see Example 1). Thus, the general method of nucleation and subsequent polymerization recited in the instant claims is taught in Shiga *et al.*

The inventors contemplate the use of additives normally incorporated into polypropylene, such as carbon black and pigments (col. 3, line 50), however, no specific amount of pigment is disclosed. Nonetheless, it is maintained that one of ordinary skill in the art would have found it obvious to arrive at the claimed range of colorant since it has been deemed that the discovery of optimum values of result-effective variables in a known process is within the level of ordinary skill in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

One of ordinary skill in the art, requiring more guidance, needs only turn to Stretanski *et al.*, which teaches polypropylene compositions containing 2.5 wt % titanium oxide as pigment (Table III), or Wang *et al.*, which reveals polypropylene resin pigmented with 5 wt % TiO<sub>2</sub> (Table 1). None of the references indicates that these amounts have detrimental effects on the polyolefin product. Therefore, it would have been obvious to one having ordinary skill in the art to use 2.5 wt %, or even 5 wt%, of TiO<sub>2</sub> pigment for imparting color to polypropylene resin, thereby arriving at the subject matter of the instant claims. One having skill in the art would reasonably expect such a combination to work because it is taught in the prior art.

Shiga *et al.* is silent with respect to the particular properties recited in present claims, however, a reasonable basis exists to believe that the prior art compositions would exhibit the same properties, especially in view of the fact that the prior art recites essentially the same composition. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Shiga *et al.* also use the composition for the manufacture of articles by the injection, extrusion, and blow molding techniques recited in present claim 12 (see col. 3, lines 60-63), and it would be obvious to one having skill in the art to use these molding techniques for making similar articles of manufacture. Regarding claim 13, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP § 2111.02. There is no indication that the composition of the prior art can not be made into the claimed articles of manufacture. As such, the composition still meets the claims.

#### ***Response to Arguments***

6. Applicant's arguments have been fully considered but they are not persuasive. Applicants suggest that none of the references discloses a method for controlling shrinkage of colored propylene compositions in molded articles, pointing out that Shiga *et al.* is directed to improving crystallization and transparency of polypropylene product.

First, it must be appreciated that motivation to combine teachings need not be identical to that of the applicant to establish obviousness. *In re Kemps*, 40 USPQ 2d. 1309, 1311 (Fed. Cir. 1996). Shiga *et al.* contemplates use of pigment, which is normally incorporated into polyolefin compositions, and apparently this would be to impart color to the thermoplastic material. One of skill in the art would find from the secondary references that 2.5 wt %, or even 5 wt%, of

pigment is acceptable. Secondly, the thermoplastic article may be simultaneously colored and transparent.

In the final analysis, the process comprised of the three steps, (a) modifying a catalyst, (b) using the catalyst, and (c) blending with 2-5 wt % of pigment is obvious over Shiga *et al.* alone, and especially in view of Stretanski *et al.* and/or Wang *et al.*

Lastly, Applicants have not met the burden of establishing unobviousness differences between their invention and that of the prior art with respect to the shrinkage properties.

In light of this and previous discussions, the rejection of record has not been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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August 16, 2005

  
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